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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,765	01/05/2004	Valerie de la Poterie	5725.0479-01	1698

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EXAMINER	
ALSTRUM ACEVEDO, JAMES HENRY	
ART UNIT	**PAPER NUMBER**
1616	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/750,765	DE LA POTERIE, VALERIE	
	Examiner	Art Unit	
	James H. Alstrum-Acevedo	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-39 are pending. Receipt of Applicant's amended claims and arguments/remarks submitted on May 26, 2006 is acknowledged.

Specification

The objection to the specification for the improper use of the trademarks **is withdrawn**, per Applicant's amendments.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

The rejection of claims 8, 14, and 33-39 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **is withdrawn** per Applicant's amendments and persuasive arguments.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claims 1-39 under 35 U.S.C. 102(b) as being anticipated by Mougin et al. (WO 97/00662, published January 9, 1997) using U.S. Patent No. 5,945,095 as its English language equivalent **is maintained** for the reasons of record.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claims 1, 6-14, 16, 19, 26, 28, and 29 under 35 U.S.C. 103(a) as being unpatentable over Potter (U.S. Patent No. 5,5898,195) **is withdrawn**, per Applicant's persuasive arguments.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,254,876 (USPN '876). Although the conflicting claims are not identical, they are not patentably distinct from each other because they are overlapping in scope and mutually obvious. Independent claim 1 of UPSN '876 claims a cosmetic composition comprising (a) liquid fatty phase; (b) at least one dye; and (c) 2-60% by weight of surface-stabilized polymer particles, selected from radical polymers (i.e. polymers made from the polymerization of monomers comprising an ethylenic bond). Dependent claim 10 of the instant application, which depends from claim 1, claims a cosmetic compositions comprising (a) a liquid fatty phase; (b) stabilized polymer particles; (c) a rheological agent; and (d) a dye. It is the Examiner's position that polymeric stabilizing agents disclosed in USPN '876 are inherently rheological agents, because all polymers are rheological agents. The language of the claims of the instant application does not preclude the stabilizing agent from also functioning as a rheological agent. Based upon this interpretation, it is noted that the dependent claims of USPN '876, similarly to the dependent claims cited in the instant rejection, claim a rheological agent that is comprised of blocks or grafts (e.g. claim 3 of the instant application and claim 8 of USPN '876). Regarding the other composition ingredients, substantially overlapping Markush groups are claimed in both the instant application and USPN '876.

Similarly to the obviousness-type double patenting rejection over USPN '876, (1) **claims 1 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,254,877 (USPN '877); (2) claims 1 and**

10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,682,748 (USPN '748).

Response to Arguments

Applicant's arguments filed May 26, 2006 have been fully considered but they are not persuasive. Applicant's traversal of the rejection of claims 1-39 as being anticipated by Mougin et al. (WO 97/00662, published January 9, 1997), using U.S. Patent No. 5,945,095 (USPN '095) as its English language equivalent, centers upon Applicant's assertion that not all the elements of the claimed invention are recited. The Examiner respectfully disagrees. Applicant's composition requires the following components: (1) a liquid fatty phase; (2) fat soluble rheological agents; and (3) polymer particles. Mougin discloses, as exemplified in claim 1 of USPN '095, a cosmetic composition comprising (1) at **least one fatty substance** and optionally at least one pulverant compound; (2) a non-aqueous dispersion of **surface-stabilized polymer particles** in at least one fatty liquid substance; and (3) at least **one surface-stabilizing polymer**. Applicant also argues that the instant claim language requires that all the components are different species. The Examiner respectfully disagrees, as there is no language in the instant claims, which prohibits the stabilizing polymer from also functioning as a rheological agent. The Examiner submits that all polymers are inherently rheological agents. Therefore, the stabilizing agent disclosed by Mougin is also a rheological agent.

Applicant's arguments, see pages 16-18, filed May 26, 2006, with respect to claims 1, 6-14, 16, 19, 26, 28, and 29 have been fully considered and are persuasive. The rejection of claims

1, 6-14, 16, 19, 26, 28, and 29 under 35 U.S.C. 103(a) as being unpatentable over Potter (U.S. Patent No. 5,5898,195) has been withdrawn.

Conclusion

Claims 1-39 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Alstrum-Acevedo whose telephone number is (571) 272-5548. The examiner can normally be reached on M-F, 9:00-6:30, with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0664. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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